

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

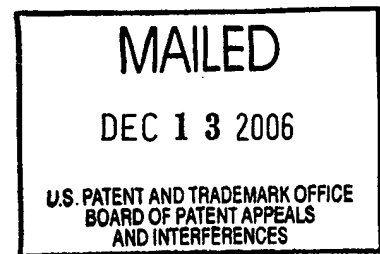
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Jonah A. Harley and Storrs T. Hoen

Appeal No. 2006-2863
Application No. 10/664,947

REMAND TO THE EXAMINER



Before KRASS, BARRY, and SAADAT, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1 and 3-24. The appellants appeal therefrom under 35 U.S.C. § 134(a). We remand.

In an *ex parte* appeal, the Board of Patent Appeals and Interferences "is basically a board of review [w]e review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (B.P.A.I. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (B.P.A.I. 1999). Our opinion addresses the following deficiencies of the examiner's answer:

- incomplete list of references
- omission of translation
- lack of specificity.

I. INCOMPLETE LIST OF REFERENCES

An examiner's answer is "required to include . . . [a] listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages."

M.P.E.P. § 1207.02 (8th ed., rev. 3 Aug. 2005). Here, although the examiner's answer lists some of the references of record, (Examiner's Answer at 4), the list is incomplete. Specifically, as noted by the appellants, (Reply Br. at 5, n.1), the list omits the following references on which the examiner relies:

- "Nishiguchi et al. (JP 4-271,284)," (Examiner's Answer at 10)
- "Hirose et al. (US 6472795)." (*Id.*)

A complete listing of **all** the references on which the examiner relies is required. The listing must include the relevant page or pages of any such references that are not patents.

II. OMISSION OF TRANSLATION

"Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art." *Ex parte Jones*, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001).

"[A] proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Id.* "To determine whether

both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." M.P.E.P. § 706.02.

Here, as aforementioned, the examiner relies on the Japanese Kokai Publication to Nishiguchi. Although he provides a copy of an English abstract of the reference and a copy of the Japanese Publication, he omits a translation thereof. "The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Braeken*, 54 USPQ2d at 1112. Accordingly, a translation of the Publication is needed for our review of the rejection. Furthermore, the examiner should base his rejection on the translation, citing thereto.

III. LACK OF SPECIFICITY

"For each rejection under 35 U.S.C. 103, the examiner's answer . . . must . . . state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection. . . ." M.P.E.P. § 1207.02. "[W]here there are questions as to how limitations in the claims correspond

to features in the prior art . . . , the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate." *Id.*


Here, although the examiner relies on Hoen, Hirose, and Nishiguchi as "all teaching that electrostatic actuators can be driven by alternating or discrete voltage," (Examiner's Answer at 10), he declines to point out where the specific teachings on which he relies are found therein. For our review, we need the examiner to cite to lines in the written description or to elements in the figures (or both) of the Hoen, Hirose, and Nishiguchi.

Any subsequent examiner's answer should be self-contained with respect to all rejections and arguments; no prior answer or Office action should be referenced or incorporated therein. Similarly, any subsequent brief submitted by the appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).


ERROL A. KRASS
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

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